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09/929,186	08/14/2001	Heinz Etter	ETTER	1212
20151	7590	01/15/2004	EXAMINER	
HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			ROBERTS, PAUL A	
			ART UNIT	PAPER NUMBER
			3731	8
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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/929,186

Applicant(s)

ETTER ET AL. *Ch*

Examiner

Paul A Roberts

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6,8-11 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,12-19,21 and 22 is/are rejected.
- 7) ☒ Claim(s) 5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s) 9.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. The applicant has elected drive 1a, blade 11a, and triangle 4c. The claims readable thereon are claims 1, 4, 5, 7, 12-19, 21, and 22. Claims 2, 3, 6, 8-11, and 20 are withdrawn from further consideration as being drawn to a nonelected invention. All claims are currently generic to claim 1.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 'rear end' must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. Additionally, a label for the operating member is missing in the drawings.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: 'rear end' in claim 1 does not have proper antecedent basis.

5. Additionally, a label for the operating member is missing in the specification.

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 12, 13, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. (Claims 13 and 15 are rejected because they contain the limitations of claim 12.) The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The housing parts are connected to support arm via a spring. The spring provides a biasing force upon the housing parts to bias the housing parts into a position in which the housing parts are deflected outwards in an area confronting the functional unit. Please explain how a biasing force pushing outwardly between two objects can provide an inward deflection. Please cite the specification and reference the drawings to support this feature. As written, there is no enablement for how a spring can provide an inward deflecting force.
8. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure does not disclose

in sufficient detail how elements 23 and 17 prevent a lateral movement of the arms. How the stop members function and how the stop mechanism functions is not understood after reading the disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The force-transmitting unit supposedly comprises an adjusting member, and the adjusting member is shown to contain rod 40 and the triangle. If that's true than what is the difference between the force transmitting unit and the adjusting member. It appears these terms are unclear because of 'double inclusion' see MPEP chapter 2100. If force transmitting unit and the adjusting member comprise exactly the same elements, than that should be clear from the claim. If they contain different elements, please cite support from the disclosure that makes the scope of force transmitting unit and adjusting member different.

10. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The housing parts are connected to support arm via a spring. The spring provides a biasing force upon the housing parts to bias the housing parts into a position in which the housing parts are deflected outwards in area confronting the functional unit. Please explain how a biasing force pushing outwardly between two objects can provide an inward deflection. Please cite the specification and reference the drawings to support this feature. As written it not clear how the spring can provide an inward deflecting force.

11. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The lateral movement of claim 15 is not understood. It isn't clear from the disclosure what constitutes a lateral movement or how the stop members serve to prevent said movement.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 4, 12, & 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Rader et al. (Rader) US 5893873. Rader discloses a surgical instrument comprising a housing with a support arm and two housing parts. A functional unit, which spreads the housing units apart, is disclosed. The housing unit has a rod and an operating member. A force transmitting unit (ftu) is disclosed. It contains an adjusting member. The ftu can change a squeezing motion in the arms into a longitudinal movement in the operating member via the rod. All the parts are labeled on the attached figure.

13. Regarding claim 4, elements 66 and 68 are considered rollers. While the shape of the applicant's rollers is very different than that of Rader, limitations in the specification are not read into claims. However, if the applicant wishes to claim annular, wheel-shaped rollers, elements 66 and 68 clearly would not anticipate that limitation.

14. Regarding claim 12, as best understood, the housing parts are swingably connected to the support arm at one end via a spring mechanism 88, which place a biasing force unto the housing parts as to seek a position in which the housing parts are deflected axially away from the support arm.

15. Regarding claims 13 and 14, the spring portion is shown as element 34, and the element defines a theoretical pivot point.

16. Regarding claim 15, element 32 (figure 2) provides a stop mechanism to prevent a lateral movement of the housing parts relative to the support arm.

17. Regarding claims 16-19, the Rader device discloses a clamping element (196) securely fastening to the functional unit. The clamping element is operatively connected to the adjusting member. The functional unit has a tube, which slides axially to close the clamping members upon actuation of the housing parts.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rader '873 in view of Chernack US 4,402,420. The Rader device contains the necessary structure to allow an end cap to placed on the back of the device where the rear end is. Rader doesn't disclose placing such a cap. Chernack discloses placing a colored cap on a port for the following

reason, "The particular color of a cap may be employed to indicate the nature or function of the port to which it is attached. For example, a white or clear (non-pigmented) cap attached to an inlet port on a cardiectomy reservoir might indicate that fluids (e.g., blood) entering through that port would next be conducted to a filtering section; a blue cap attached to other ports on a cardiectomy reservoir might indicate those ports are intended to function as inlet ports for suction lines or left ventricular sump lines; a red cap attached to a port might indicate that such port is intended to accept medication, e.g., heparin, which does not require filtering; and a yellow cap attached to a port might indicate that such port is intended to serve as a vent means or as a site to which a vacuum source can be attached." While this is a different type of device, the teaching of Chernack would still be useful to apply to the Rader device, because the alternate uses for the Rader device can be used for alternate purposes. Rader clearly recognizes multiple tools can be placed on the end of his device since he says, "Tool 196 is a suitable surgical tool as known in the art." At the time of the invention it would have been obvious to one having ordinary skill in the art to place an appropriate colored cap on the back of the Rader device as taught by Chernack, because doing so would allow an operator to quickly determine the tool's function.

***Allowable Subject Matter***

19. Claims 5 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: In claim 5, a wedge shaped head as part of the adjusting member is not disclosed.



***Conclusion***

The examiner would like to thank Ursula Day for the interview held January 6<sup>th</sup>, 2004, to enable the examiner to understand the scope and limitations of claim 15. While, an agreement wasn't reached as to whether or not this feature is enabled by the disclosure, the examiner was able to search for the applicant's invention with a complete understanding of how the device actually works.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are microsurgical tools have structure similar to the applicant's device. US 5,868,761; 5,208,357; 5,290,302; 5,370,658; 6,024,748.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Roberts  
Paul.Roberts@uspto.gov  
01/11/04

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

